



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,309	01/19/2000	Shosaku Kawai	2406-4	3008
22204	7590	01/21/2004	EXAMINER	
			JAROENCHONWANIT, BUNJOB	
		ART UNIT		PAPER NUMBER
		2143		14
DATE MAILED: 01/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/487,309	KAWAI, SHOSAKU	
	Examiner	Art Unit	
	Bunjob Jaroenchonwanit	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 37,38 and 52-55 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 27-36 and 39-51 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 December 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

1. This Office action is response to the amendment filed 12/01/03, the amendment has been reviewed. Original claims 1-27 are cancelled; claims 28-55 are added. The objections and rejections cited are as stated below.
2. Newly submitted claims 37-38 and 52-55 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the instant claims' subject matter coincides with subject matter of claims 14-21 and 23-27, as originally filed, in which the applicant withdraw from consideration, as stipulated in the remark. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 37-38 and 52-55 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.
3. The drawing correction to Figure 28 is acknowledged.
4. Regarding, the response to rejection under 35 U.S.C. 112, applicant submitted that the primary connection information and identity in formation is clearly defined in page 10, line 27-Page 11, line 4. Although the examiner disagreed that the teaching in cited passage is clearly not defined the phrases, however examiner has taken that the primary connection information is any information, which is used for electronically establishing connection, e.g., telephone number, or IP address. The identity information is referred to any address related to the primary connection information owner, which may includes name, sex, profile
5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 2143

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach, in such clear and concise manner to enable an ordinary skill in the art to pertain, make and use to invention without undue experimentations, i.e., failing to disclose how ton displays the identity information on a second communication device to the operator of the first communication device, prior to the connection is being made (see wherein statements 2, 4 and 5). In addition the specification failed to discloses how the primary connection and identity information for the connected device is send to a device, which is not connected to the second communication device at the time, as recited in claims 29-32.

Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the claimed method. See In re Gunn, 190 USPQ 402, 406 (CCPA 1976

7. Claims 28-36 and 39-51 are rejected under 35 U.S.C. 112, first paragraph, for reason set forth in the objection to the specification.

It is suggested that applicant could overcome 112/first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams) or the claim can be made clear that the operator referred thereto, is an operator of the second communication device. No new matter should be added.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 2143

9. Claims 28-36, 39-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 29-30, the phrase “its operator” renders the claim(s) indefinite because it is not clear whether which device’s operator, it’s referred thereto, thereby, the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

11. Regarding claim 30, the term “itself” renders the claim(s) indefinite because it is not clear whether which device, itself referred thereto, thereby, the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

12. Regarding claims 28-30, the term “the identity information” renders the claim(s) indefinite because the identity information is preceded with three different identities information, it is not clear whether which identity information referred thereto, thereby, the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

13. Claims 31-32 recite the limitation “the identity information and primary connection information received from another device”. There is insufficient antecedent basis for this limitation in the claim.

14. Regarding claim 32, the term “the connected communication device” renders the claim(s) indefinite because there are many devices connected to the each other, as recited in claim 30-32, it is not clear whether which device applicant referred thereto, thereby, the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

15. Regarding claims 35, 43-46 the phrase “which communication device” renders the claim(s) indefinite because there are many devices connected to the each other, as recited in

claim 30-32, it is not clear whether which device applicant referred thereto, thereby, the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

16. Claim 40 recites the limitation "the authorization is obtained". There is insufficient antecedent basis for this limitation in the claim.

17. Applicant argument regarding claims 28-30 is found persuasive; the prosecution could be advance upon amending to overcome the rejection above.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone numbers for the

Art Unit: 2143

organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.



Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj

January 15, 2004